

## **Remarks**

This Response is timely filed with a Request for a one-month extension of time. The appropriate fee is submitted herewith pursuant to 37 CFR 1.17.

Claims 1-5 are pending in this application. By this amendment, Claim 1 is amended. No new matter has been added. Reconsideration of the application in view of the above amendments and the following remarks is respectfully requested.

### **I. The Claims Comply With 35 U.S.C. 112, second paragraph**

Claims 1-5 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully submits that the amendment to claim 1 resolves the basis of the rejections, and respectfully requests their withdrawal.

### **II. The Claims are Patentable Over the Cited References**

Claims 1-5 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of European Patent Application No. 0508245 (hereinafter "EP '245") and European Patent Application No. 0468318 (hereinafter "EP '318"). Applicant respectfully traverses this rejection.

As amended, Claim 1 recites an air-conditioning system comprising a cooling module (2) which comprises a three-way switching valve (V1) whose central outlet is connected to an intake tube (5) of a single hydraulic circuit (5, 7), an inlet is connected to a second outlet tube (F) of a heating system (8), and an inlet is connected to a first outlet tube (A) of the cooling module (2). Claims 2-5 depend from Claim 1 and include at least all of the limitations recited therein.

In order to establish a *prima facie* showing of obviousness under Section 103, the Examiner must set forth three basic criteria. First, the prior art reference (or the references when combined) must teach or suggest all of the claim limitations. See Manual of

Patent Examining Procedure (“M.P.E.P.”) § § 706.02(j), 2142 (8th ed., 2nd Rev., 2004).

Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. *Id.* Finally, there must be a reasonable expectation of success in the combination. *Id.*

Taken alone or in combination, neither EP ‘245 nor EP ‘318 teach or disclose the claimed elements of the present invention. EP ‘245 discloses a cooling module for boilers having a switching valve (V3) for connecting a single hydraulic circuit to the boiler during the winter period and to the cooling module during the summer period. The valve (V3) disclosed in EP ‘245 is connected to the outlet pipe (12) of a heat exchanger (20) and to the inlet pipe (14) of an accumulator (10) and to a pipe (15). See Col. 3, ll. 40-55. The valve (V3) does not comprise a three-way switching valve whose central outlet is connected to an intake tube of a single hydraulic circuit, as presently claimed. Moreover, the valve (V3) does not include an inlet connected to a second outlet tube of a heating system, and an inlet connected to a first outlet tube of a cooling module, as presently claimed.

EP ‘318 discloses a monobloc heating and cooling system including a valve (V2). The valve (V2) disclosed in EP ‘318 is connected to a boiler (10), a return pipe (25), and a water heater C. See Col. 4, ll. 20-45, Fig. 1. The valve (V2) does not comprise a three-way switching valve whose central outlet is connected to an intake tube of a single hydraulic circuit, as presently claimed. Moreover, the valve (V2) does not include an inlet connected to a second outlet tube of a heating system, and an inlet connected to a first outlet tube of a cooling module, as presently claimed. As such, the cited references, taken alone or when combined, do not teach or suggest all of the claim limitations

In addition, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to

modify or combine EP '245 and/or EP '318. The Examiner does not provide any authority in EP '245 to combine with the system disclosed in EP '318, and vice versa. The only apparent motivation for combining the references arises from the claimed invention itself, which constitutes hindsight motivation and cannot be relied upon as a reason to combine references.

Lastly, there is no reasonable expectation of success in the combination of the system disclosed in EP '245 with the EP '318 system. In the present Office Action, the Examiner states that "EP '318 teaches, in the same type of system as disclosed in EP '245, placing a storage reservoir 8 upstream of the pump P1" and that:

[t]o have moved the storage reservoir of EP '245 from its disclosed location to a location upstream of pump P2. . . in EP '245, to advantageously assure the pump P2 an adequate supply of fluid would have been obvious to one of ordinary skill in the art, in view of the showing of EP '318.

However, the Examiner fails to appreciate that while EP '245 specifically teaches the use of a single accumulator 8 as storage for water at *both* warm and cold temperatures, depending on system needs (*See* Col. 5, ll. 50-51; Col. 6, ll. 23-24), the EP '318 system teaches the use of an accumulator for storing *only* refrigerated water. *See* Col. 4, ll. 21-55.

With reference to Figure 1 of EP '245, the Examiner's proposed modification requires moving tank 10 from its described position to a position proximate upstream of pump P2. This modification would place the tank 10 outside of the warm water circuit of the EP '245 system. In addition, this modification would place the tank 10 upstream of the heat exchanger 2, rather than its required downstream position. As a result, the tank 10 would be unable to hold cold water, which is the express function required in the EP '245 system. *See* Col. 5, ll. 50-51; Col. 6, ll. 23-24. Accordingly, the Examiner's proposed combination of EP '245 and EP '318 would impermissibly render EP '245 unsatisfactory for its intended purpose. *See* M.P.E.P. § 2143.01.

Claims 1-5 were also rejected under 35 U.S.C. 103(a) as being unpatentable over EP '245 and EP '318 and further in view of U.S. Patent No. 5,244,037 to Warnke (hereinafter "Warnke"). Applicant respectfully traverses this rejection.

Taken alone or in combination with EP '245 and EP '318, Warnke does not teach the subject matter of the present invention. Warnke is directed to a pressurized system for a heat pump. The system includes a tank 26 having an outlet pipe 36 with a pair of one-way valves 42, 44 disposed in the pipe. See Col. 3, ll. 7-30, Fig. 2. The system disclosed in Warnke does not teach or suggest the use of a three-way switching valve. The Warnke system does not suggest a valve whose central outlet is connected to an intake tube of a single hydraulic circuit, as presently claimed. Moreover, Warnke does not disclose or suggest a switching valve having an inlet connected to a second outlet tube of a heating system, and an inlet connected to a first outlet tube of a cooling module, as presently claimed. As such, Warnke, taken alone or when combined, do not teach or suggest all of the claim limitations

Further, there is no suggestion or motivation to modify or combine the systems disclosed in EP '245 and EP '318 and/or Warnke. Applicant reiterates, and incorporates herein, the arguments expressed above regarding the combination of EP '245 and EP '318. In addition, Warnke and the other cited references are directed to entirely different technical fields. Warnke is directed to the field of pressurized, closed loop, ground source, liquid systems for a heat pump. See Col. 1, ll. 7-11. These systems typically "utilize a fluid other than water to retard freezing." See Col. 1, ll. 20-23. In contrast, the systems disclosed in EP '245 and EP '318 include water-based circuits. One would not expect a practitioner of the arts of non-water based systems to look for solutions and designs in the water-based circuit arts. The lack of motivation to combine the references is emphasized by the fact that the subject matter of the cited references is so distinct, the references are classified under separate international classifications. Again, the only apparent motivation

for combining the references arises from the claimed invention itself, which constitutes hindsight motivation that cannot be relied upon as a reason to combine references.

For at least the reasons set forth above, Applicant respectfully submits that EP '245, EP '318, and Warnke, taken alone or in any combination, fail to disclose, teach, or suggest the invention as claimed by Applicant. Accordingly, Applicant respectfully requests that the Examiner reconsider, and withdraw, the rejections and allow the appended claims at an early date.

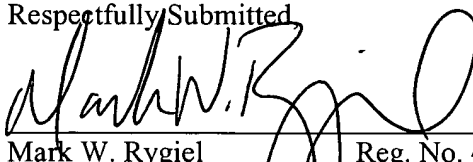
**III. Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims of the present invention define subject matter patentable over the references cited by the Office and that the application is in condition for allowance. Should the Office believe that anything further is desirable to place the application in better condition for allowance, the Office is invited to contact Applicant's undersigned attorney at the below listed telephone number.

The appropriate fee for a one-month extension of time is submitted with this response pursuant to 37 CFR 1.17. Should any additional fee be required, the Commissioner is hereby authorized to charge the required fee to Collier Shannon Scott Deposit Account No. 03-2469. Moreover, if the deposit account contains insufficient funds, the Commissioner is hereby invited to contact Applicant's undersigned representative to arrange payment.

Date: September 30, 2005

Respectfully Submitted,

  
Mark W. Rygiel Reg. No. 45,871  
**COLLIER SHANNON SCOTT, PLLC**  
3050 K Street, NW, Suite 400  
Washington, D.C. 20007  
(202) 342-8400